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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,300	05/15/2001	Jay S. Walker	00-030	8793
22927	7590	12/06/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/855,300	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> James W. Myhre	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| (5) Paper No(s)/Mail Date <u>20010601; 20010604; 20010604; 20020506; 20031007</u>                  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The five information disclosure statements (IDS) submitted on June 1, 2001; June 4, 2001; June 4, 2001; May 6, 2002; and October 7, 2003 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner. Signed copies are attached hereto.

### ***Claim Objections***

2. Claims are objected to because of the following informalities:

Claims 22 and 31 are incomplete. The Examiner believes that these two claims should contain the same limitations as Claims 3 and 12, respectively. However, it appears that when copying the limitations, the Applicant deleted the last few words in each of these claims. The Examiner will consider these claims as containing the same limitations as Claims 3 and 12. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to non-functional descriptive material, i.e. a printed document. Per MPEP 2106B1: Descriptive material

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can be characterized as either functional descriptive material or nonfunctional descriptive material. In this context, functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. Nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Both types of descriptive material are nonstatutory when claimed as descriptive material *per se*. *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. The claimed billing statement is merely a document containing information, presumably about a monetary amount owed by the receiving party. Therefore, none of the claims include any functional language describing actions to be taken to nor procedures to be followed in order to produce the invention, and are thus considered to be nonfunctional descriptive material.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for generating a billing statement, does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to determine the step or steps needed to arrive at the invention commensurate in scope with these claims. Claims 38 and 39 recite a single step of "generating a billing statement...", thus, these two claims are single step process claims

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akin to the single means claims addressed in MPEP 2164.08(a). By definition, a process is the combination of two or more steps. "A single means claim, i.e. where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). (A single means claim which covered every conceivable means for achieving the state purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated purpose (result) while the specification discloses at most only those known to the inventor."

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 10-13, 20, 21, 23, 30, 31, 35-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson et al ("College Accounting, Eighth Edition).

Claims 1, 20, and 23: Carson discloses a billing statement comprising a description of a transaction and an offer pointer associated with the transaction, wherein the offer pointer comprising information that may be used to review an offer (page 331).

Claims 2 and 21: Carson discloses a billing statement as in Claims 1 and 20 and further discloses the billing statement is a printed document (page 331).

Claim 10: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer pointer is not an offer (page 331).

Claims 11, 12, 30, and 31: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement describing a plurality of transactions and that the offer pointer is associated with one or more of the transactions (page 331).

Claim 13: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer is an offer to reduce the amount owed with the associated transaction (page 331).

Claims 35-37: Carson discloses a billing statement as in Claim 20 above, and further discloses that the amount owed is equal to the minimum payment (i.e. pay-in-full), equal to the cost of the transaction (i.e. pay-in-full), or equal to the total amount owed described in the billing statement (i.e. payment for all transactions)(page 331).

Claims 38 and 39: Carson discloses a method comprising generating a billing statement with a description of a transaction and an offer pointer that can be used to view an offer associated with the offer pointer (page 331).

Claims 40 and 41: Carson discloses a method comprising receiving transaction information, determining an offer/offer pointer based on the transaction information, and transmitting the offer pointer on a billing statement (page 331).

Claims 42 and 43: Carson discloses a method comprising receiving an offer pointer associated with a transaction on a billing statement, transmitting the offer to the customer, and determining a new amount owed by the customer if the offer is accepted (page 331).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-9, 14-19, 22, 24-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al ("College Accounting, Eighth Edition).

Claims 3 and 22: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement is a printed document. While it is not explicitly disclosed that the billing statement could also comprise viewable electronic data (i.e. electronic document), Official Notice is taken that it is old and well known to present billing and other financial information as viewable electronic data (i.e. computer displays). For example, for the past several decades customers have been able to access their financial data, to include statements, on electronic devices such as ATM machines. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the billing statement from viewable electronic data (i.e. an electronic billing statement). One would have been motivated to provide an electronic billing statement in order to allow remote access to the data without necessitating printing, collating, and mailing a hard copy of the information to the customer.

Claims 4-9 and 24-29: Carson discloses a billing statement as in Claims 1 and 23 above, but does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer. For example, Carson discloses an offer pointer ("See note below") on line 8 of the billing statement which directs the customer to the offer (in the "AGENT PLEASE NOTE"



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section) printed on the bottom of the billing statement. If the offer consisted of a number of terms which would not have fit on the bottom of the page, the pointer would have directed the customer to the appropriate location, such as "See page 2", "Call (202) 111-1111 for terms of offer", "Terms of offer available at 2021 Roosevelt Street, Alexandria, VA 20221", "Terms of offer available at [www.offer.com](http://www.offer.com)", "Terms of offer may be requested via fax at (202) 111-1112", etc., depending on the communicative abilities of the billing statement provider's system. One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL, in order to take advantage of the latest communication means available at the time of invention.

Claims 14-16: Carson discloses a billing statement as in Claim 1 above, and further discloses the terms of the offer is to reduce the amount owed for the transaction. While it is not explicitly disclosed that the terms of the offer is to reduce the interest rate, to extend the due date, or to eliminate the minimum amount due, these are all well known types of offer terms used by billers to entice customers to remit payments early, to use a particular form of remittance (electronic vs check), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the terms of the offer so as to eliminate the minimum amount due, extend the due date, or change the interest rate. One would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present.

Claims 17 and 32: Carson discloses a billing statement as in Claims 1 and 20 above and further discloses the billing statement comprises a second description of a second transaction, but does not explicitly disclose a second offer pointer associated with the second transaction. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the same or different offer terms for each of the transactions listed on Carson's billing statement. One would have been motivated to provide separate offers for separate transactions in order to allow the biller to "push" certain types of transactions. For example, a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.

Claims 18 and 33: Carson discloses a billing statement as in Claims 17 and 32 above, and further discloses the second offer is the same as the first offer (i.e. the same offer pertains to all of the transactions listed on the billing statement)(page 331).

Claim 19 and 34: Carson discloses a billing statement as in Claims 1 and 20 above, but does not disclose that the offer is located adjacent to the transaction description. However, it is a design choice of the biller on where to place the various information and data on the billing statement page. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the offer adjacent to the transaction information to which the offer pertains. One would have

been motivated to place it adjacent in order to allow the customer to quickly identify which offer pertained to which transaction (if the offers were not all the same).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Anderson et al (6,804,337) discloses a billing statement generator for generating billing statements, both electronic and printed, which includes discounts on the transactions displayed thereon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

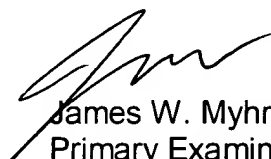
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM

December 1, 2005



James W. Myhre

Primary Examiner

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